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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/008,478 | 12/10/2001 | Michael Z. Yuan | A8237 | 5630 |

7590 08/10/2004

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EXAMINER

LAMB, BRENDA A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/000,420

Applicant(s)

Yuan

Examiner

LAMB

Group Art Unit

1734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/26/2004
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-11 and 22-38 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☒ Claim(s) 7, 9, 32 and 38 is/are allowed.
- ☒ Claim(s) 1, 2, 5, 6, 22, 23, 25, 26, 30, 31, 34-37 is/are rejected.
- ☒ Claim(s) 3, 4, 8, 10, 11, 24, 27-29 and 33 is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Claims 34 –36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The omission that the helical member is a spring member or resilient member presents new matter since it reads on a non-resilient member. The originally filed specification claims a sizing die includes a helically shaped resilient member or helically shaped spring member but is silent as to a non-resilient member having a helical shape. The originally filed specification fails to teach or suggest a conically shaped spring.

Claims 1-2, 5-6, 22, 23, 25, 26, 30, 31 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation in claims 1 and 2 that the orifice is adjustable is indefinite since no means for adjusting the orifice are recited.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 5, 6, 22-23 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Britton et al.

Britton et al teaches the design of an apparatus comprised of a coating unit having a size die with an orifice through which the elongated member is conveyed. Britton et al teaches the size die includes a resilient member 38, which appears as a helical compression spring that defines the orifice. Britton et al teaches the orifice of the coating unit is adjustable. Thus every element of claims 1-2 and 37 is taught by Britton et al. With respect to claims 5-6 and 22-23, Britton et al apparatus is capable of coating an optical fiber or conductive member. With respect to claim 24, Britton et al. shows a tensioning member 36 for adjusting the tension of the resilient member.

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Britton et al.

Britton et al is applied for the reasons noted above but fails to teach the shape of the resilient member is conical. It would have been an obvious matter of design choice to make the spring in the Britton et al apparatus a conical shape since such a modification would have involved a mere change in the shape of a component. (see In re Dailey 149 USPQ 47).

Applicant's arguments filed 4/26/2004 have been fully considered but they are not persuasive.

Applicant's argument that Britton et al spring fails to define the orifice is found to be non-persuasive. Britton et al spring puts compression force on control plate 24 which obviously would enable the above cited plate to move vertically dependent on the degree of compression force thereby defining the size of the orifice.

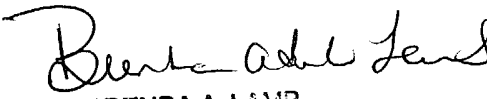
Claims 3, 4, 8, 10, 11, 24, 27-29 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 25-26 and 30-31 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 7,9, 32 and 38 are allowed.

Any inquiry concerning this communication should be directed to Brenda A Lamb at telephone number (571) 272-1231. The examiner can normally be reached on Monday thru Tuesday and Thursday thru Friday with alternate Wednesdays off.

B. A. Lamb/af
July 13, 2004


BRENDA A. LAMB
PRIMARY EXAMINER